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8554 Katy Freeway, Suite 100
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Bus: (713) 468-8880
Fax: (713) 468-8883

Fax

To: Technology Center Director **From:** Rhonda L. Sheldon

Company: USPTO Group Art Unit 2857 **Date:** March 31, 2006

Fax: (571) 273-8300 **Pages:** 8

Your Re: Serial No. 09/619,219 **Our Re:** ITL.0417US (P9042)

Urgent **For Review** **Please Comment** **Please Reply** **Confirm Receipt**

AFTER FINAL—PLEASE EXPEDITE

Attorney Docket No.: ITL.0417US (P9042)
Date: March 31, 2006

RLS/njm

Applicant(s): Steven R. Bard
Serial No.: 09/619,219
Filing Date: July 19, 2000
Title: Providing Power From A Power Source To A Power Sink

1. Petition to the Technology Center Director under 37 C.F.R. § 1.181 and MPEP § 1002.02(c)

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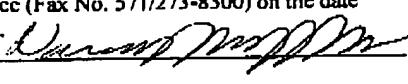
Applicant:	Steven R. Bard	§ Group Art Unit:	2857
Serial No.:	09/619,219	§ Examiner:	Manuel L. Barbee
Filed:	July 19, 2000	§ Atty. Dkt. No.:	ITL.0417US (P9042)
For:	Providing Power from a Power Source to a Power Sink	§ Assignee:	Intel Corporation
Customer No.:	21906	§ Confirmation No:	1192

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Petition to the Technology Center Director Under 37 C.F.R. § 1.181 and MPEP § 1002.02(c)

The examiner's final rejection is premature due to a §112 rejection that was first asserted in a final Office action. The basis for the §112 rejection however, was not an issue in the prior, non-final Office action even though the limitation in question was substantially the same before and after amendment. Given that the examiner did not object to or reject any claims under §112 in a first Office action, instead waiting to reject certain claims under § 112 in a second and final Office action the finality of the second Office action is believed to be premature.

Additionally, the examiner refused to enter amendments after final even though the amendments place the application in better form for appeal without raising new issues that would require further search and consideration. Thus, the examiner's refusal to enter the amendments submitted is also believed to be improper.

Date of Deposit: March 31, 2006
Pursuant to Rule 1.8(a), I hereby certify that this document and authorization to charge deposit account is being facsimile transmitted to the United States Patent and Trademark Office (Fax No. 571/273-8300) on the date indicated above. 
Nancy Meshkoff

Facts Involved

1. On or about August 13, 2004 the applicant filed a Request for Continued Examination (RCE) including a Preliminary Amendment. As an example, amended claim 1 recited:

A method comprising:
detecting the coupling of a power sink to a power source;
automatically providing a *power class identifier* to said sink; and
using said power class identifier in said power sink to determine whether to receive power from said power source.
2. On August 22, 2005, the examiner issued a first Office action after RCE.¹ In the Office action, claim 1, for example, was only rejected over prior art.
3. On November 15, 2005, the applicant replied the First Office action. The Reply included claim amendments. Amended claim 1, as one example, recited:

A method comprising:
detecting the coupling of a power sink to a power source;
automatically receiving a *power class identifier* in said sink; and
using said power class identifier in said power sink to determine in said sink whether to receive power from said power source.
4. On January 10, 2006, the examiner issued a final Office action.² In addition to rejections over cited art, the final Office action included a §112 rejection of claims 1-3 and 6-10.
5. On or about January 25, 2006 the applicant filed a response to final rejection. In the response, the applicant requested that the examiner reconsider the finality of the Office action in view of the new §112 rejection. In the response, the applicant amended claims such as claim 1. As amended, claim 1 recites:

A method comprising:
detecting the coupling of a power sink to a power source;
automatically receiving a signal in said sink; and
using said signal in said power sink to determine in said sink whether to receive power from said power source.
6. In the Advisory Action dated February 6, 2006,³ the examiner refused to withdraw the finality of the Office action and he refused to enter the claim

¹ Paper No. 07112005

² Paper No. 12272005.

amendments. The examiner also asserted that the §112 rejection is proper as it was necessitated by the applicant's amendment.

7. Because the applicant does not agree with the examiner, the applicant brings this petition.

Points to be Reviewed

1. In view of the §112 rejection that was newly asserted in the Office action dated January 10, 2006 should the examiner have made that Office action a final Office action?
2. As the amendments to the claims overcome the §112 rejection did the examiner err in refusing to enter the amendments, which, if entered, would place the application in better form for appeal?

Requested Action

The decision-maker is requested to have the finality of the Office action dated January 10, 2006 withdrawn and to enter the amendments submitted on January 25, 2006. In the alternative, the decision-maker is requested to enter the amendments submitted on January 25, 2006.

Legal Argument

During the examination of a patent application, it is common practice to make a second Office action a final Office action.⁴ But a second Office action should not necessarily be final if an issue was not yet clearly developed or if a new ground of rejection is asserted that was not necessitated by an amendment.⁵ In this case, claims 1-3 and 6-10 were first rejected under §112 in a final Office action due to a lack of disclosure for "*using a power class identifier to determine in the sink whether to receive power from a power source.*"⁶ But claim 1, for example, previously recited, "*using said power class identifier in said power sink to determine whether to receive power from said power source.*"⁷ Given that the examiner did not object to or reject any claims under §112 in a first Office action, instead waiting to reject claims 1-3 and 6-10 under §112 in a second and final Office action, was the finality of the second Office action premature?

³ Paper No. 01312006

⁴ See MPEP §706.07(a).

⁵ See MPEP §706.07; MPEP §706.07(a)

⁶ Paper No. 12272005, page 2 (emphasis added).

⁷ Preliminary Amendment dated August 13, 2004.

The question of whether there was support for using a power class identifier in a sink to make a determination was not made clear before the final Office action. For example, in a preliminary amendment submitted with an RCE, the applicant asserted that the claims had been amended to call for “enabling *the sink to make the determination* of whether to receive power from a power supply *based on a power supply identifier* received from the power source.”⁸ In response thereto, the examiner did not object to or reject any of the claims under §112. Rather, he argued that claim 1 did not have limitations for “*a sink to decide* whether to obtain power from a source,” but the applicant’s disclosure “*supports a sink that may determine* whether the source is valid to charge its internal battery.”⁹ Additionally, the examiner asserted, “there is no support for *a source that provides* power class information to a sink for the purpose of allowing the sink to decide whether to obtain power from the source.”¹⁰ Thus, even though the applicant made clear that it believed the sink made a determination based on the identifier, the examiner did not object to or reject the claims because a determination is based on the identifier. Stated another way, the examiner did not address support for *using a power class identifier* in the sink to make a determination even though claim 1 called for *using a power class identifier* in a power sink *to determine* whether to receive power from a power source. Given the applicant’s arguments that the sink makes a determination based on the identifier¹¹ and the examiner’s assertions that claim 1 was not limited to making a determination in the sink¹² it was foreseeable that the applicant might amend claim 1 to call for *using the power class identifier in the power sink to determine in the sink* whether to receive power from the power source. In sum, the *use of* a power class identifier to make a determination in a power sink did not appear to be an issue in the first Office action.

For the examiner to then reject claims in a final Office action, including claim 1, under §112 ¶1 because “there is no support for *using a power class identifier* to determine in the sink whether to receive power from a power source” is contrary to the Patent Office’s policies.¹³ Although present practice is to make a second action final this does not sanction hasty and ill-

⁸ Preliminary Amendment dated August 13, 2004, page 5.

⁹ Paper No. 07112005, page 5 (emphasis added).

¹⁰ *Id.*

¹¹ Preliminary Amendment, page 5.

¹² Paper No. 07112005, page 5.

¹³ Paper No. 12272005, page 2.

considered final rejections.¹⁴ Moreover, the applicant is entitled to a full and fair hearing and a clear issue should be developed before appeal.¹⁵ Because claim 1 recited, “*using a power class identifier in a power sink to determine...*” before and after response to the first Office action, the applicant was denied a full and fair hearing and/or the issue was not clear. The examiner knew that the applicant regarded his invention as enabling a sink to make a determination and that the sink’s determination is based on an identifier.¹⁶ The examiner addressed decision-making in the sink and the lack of support for *providing* a power class identifier to the sink *from a power source*, but the examiner did not identify that *using the power class identifier in the sink to make a decision* was a potential problem even though this was clearly the intent of the claim. Thus, the issue was brewing—in the first Office action, the examiner could have addressed using a power class identifier in the sink to make a determination, but he did not. Claiming *using a power class identifier* to make a determination in the sink in claim 1 should have been foreseeable in light of the claim language, the applicant’s explanation in the preliminary amendment, and the examiner’s discussion in the first Office action. Thus, it is submitted that the finality of the second Office action prematurely cut off prosecution of the application, preventing a clear issue from developing.

The examiner contends that the second Office action is not premature because the §112 rejection was necessitated by the applicant’s amendment.¹⁷ As explained above, the limitation of *using a power class identifier in a power sink* (to make a determination) was present in claim 1 before and after the first Office action. The examiner did not object to or reject any claim in the first Office action based on the use of the power class identifier in the sink. Instead, he waited until the next Office action to do so. Because the amendment did not change that portion of the claim, the amendment did not necessitate the §112 rejection. Clearly, the finality of the rejection is premature.

Even if the examiner did not voluntarily withdraw the finality of the second Office action he should have entered the amendments to overcome the §112 rejection. Amendments that place an application in better form for appeal or that comply with objections or rejection of

¹⁴ MPEP §706.07.

¹⁵ *Id.*

¹⁶ See, e.g., Preliminary Amendment dated August 13, 2004, page 5.

¹⁷ Paper No. 01312006.

form should be entered even if after a final rejection.¹⁸ In the Advisory Action, the examiner refused to enter the amendments submitted after final because allegedly they did not place the application in better form for appeal by materially reducing or simplifying the issues for appeal.¹⁹ The examiner did not assert that the amendments raise new issues that would require further consideration and/or search.²⁰

The claim amendments overcome the §112 rejection; therefore, if entered the amendment would place the application in better form for appeal. For instance, independent claim 1 was amended to recite automatically *receiving a signal* in the sink and *using the signal* in the power sink to *determine in the sink* whether to receive power from the power source. As described in the specification:

...the source 12 may provide a specific signal to the sink 14 for example through a reserved pin on a link 16a. The sink 14, upon detecting the signal, may determine that it may charge its internal battery from the power available from the source 12.²¹

As the specification clearly supports the amendments, entering the amendments will remove the §112 rejection. An amendment that removes an entire ground of rejection without raising new issues that would require further consideration and search surely *must* simplify the issues for appeal by putting the application in better form for appeal. Therefore, the examiner's refusal to enter the amendments is believed to be arbitrary and capricious, and an abuse of his discretion. The decision-maker is requested to enter the amendments even if the finality of the second Office action is not withdrawn.

Fee

A petition brought pursuant to Rule 1.181 does not have a fee expressly provided for in Rule 1.17. The Commissioner is authorized to charge any additional fees or credit any overpayments to Deposit Account No. 20-1504 (ITL.0417US).

¹⁸ MPEP § 714.13

¹⁹ Paper No 01312006.

²⁰ *Id.*

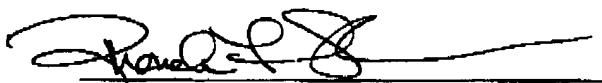
²¹ Specification, page 3, lines 11-16.

Statement that Petition is Timely Filed

The complained about action took place on February 6, 2006; thus, this matter has been addressed within two months of that date.

Respectfully submitted,

Date: March 31, 2006



Rhonda L. Sheldon
Registration No. 50,457
Trop, Pruner & Hu, P.C.
8554 Katy Freeway, Suite 100
Houston, Texas 77024
(713) 468-8880 [Phone]
(713) 468-8883 [Fax]

Attorneys for Intel Corporation